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## **REMARKS**

This submission is in full response and timely to the aforementioned Office Action. Claims 1 to 5 correspond to claims originally allowed, and patented, and are here again allowed. Claim 6 was also allowed. Claims 7 to 11 and 14 to 18 are here presented in underlined form for the convenience of the examiner and have been refused as allegedly falling amok of the “recapture rule”.

The sole issue presented by this recent Action is whether the pending claims included narrowing limitations added via the reissue that did serve to materially narrow the overall broadened claims in a manner effective to avoid a recapture bar. Not surprisingly, the Applicant contends that the current claims include materially narrowing limitations sufficient to overcome the reissue recapture rule for the broadened claims; the examiner steadfastly holds that they are not. There is no question that the claims are broader than claims 1 to 5 of the patent in that a claim broader in any one respect is a broader claim, no matter how much narrower in any other respect. See pages 3 and 4 of the Action, and the prior exchanges, including the reissue oath.

What are we really talking about when we discuss the “reissue recapture rule”? The statutes, Federal Circuit case law, the Board of Appeals case law, and the MPEP provide the requisite guidance not followed in this application.

### **I. Text of Reissue Statute**

The first and fourth paragraphs of the current reissue statute provide in pertinent part:

(1) Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall ... reissue the patent for the invention disclosed in the original patent .... No new matter shall be introduced into the application for reissue... (Emphasis added)

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(4) No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

35 U.S.C. § 251 (2003).

## **II. Recent Federal Circuit Decisions on the Recapture Rule**

Historically, the Federal Circuit has recognized that the reissue “error” described in 35 U.S.C. § 251 may be liberally construed to include “an attorney’s failure to appreciate the full scope of the invention.” Mentor Corp. v. Coloplast, Inc., 998 F.2d 992, 995 (Fed. Cir. 1993) (quoting In re Wilder, 736 F.2d 1516, 1519 (Fed. Cir. 1984)). However, courts have carefully limited what may constitute “an attorney’s failure to appreciate the full scope of the invention.” As described by the court in Mentor, “if a patentee tries to recapture what he or she previously surrendered in order to obtain allowance of the original patent claims, ‘that deliberate withdrawal or amendment ... cannot be said to involve the inadvertence or mistake contemplated by 35 U.S.C. § 251, and is not an error of the kind which will justify the granting of a reissue patent which includes the matter withdrawn.’” 998 F.2d at 995 (quoting In re Willingham, 282 F.2d 353, 357 (CCPA 1960)).

In the last ten years, however, the Federal Circuit has manifested a general reluctance to declare reissue claims which are broader than original patent claims impermissible *per se*, and instead has migrated toward a fact-specific analysis to be used on a case-by-case basis. A brief review of these cases demonstrates this reluctance and gradual shift.

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In 1993, the Federal Circuit in Mentor recognized that “[r]eissue claims that are broader in certain respects and narrower in others may avoid the effect of the recapture rule.” Id. at 996. The court then went on to state that if “a reissue claim is broader in a way that does not attempt to reclaim what was surrendered earlier, the recapture rule may not apply.” Id.

In 1997, the Federal Circuit further clarified the holding of Mentor by establishing a three-step process to follow when applying the recapture rule of 35 U.S.C. § 251. In re Clement, 131 F.3d 1464, 1468-69 (Fed. Cir. 1997). As set forth by the court in Clement, the first step is to “determine whether and in what ‘aspect’ the reissue claims are broader than the patent claims.” Id. Second, the court must “determine whether the broader aspects of the reissued claim related to surrendered subject matter.” Id. Finally, once the court has determined that an applicant has surrendered the subject matter of the canceled or amended claim, the court must determine “whether the surrendered subject matter has crept into the reissue claim.” Id.

Although the court in Clement recognized that reissue claims may be both narrower and broader in some aspects than the related patent claims, the court found that “if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim.” Id. at 1470. In other words, the holding in Clement appears to stand for the proposition that reissued claims may only be broader than patent claims when they are “broader in an aspect unrelated to [a previous] rejection.” Id.

One year later, without explicitly doing so, the Federal Circuit in Hester Industries, Inc. v. Stein, Inc., effectively modified this minor premise in Clement. 142 F.3d 1472 (Fed. Cir. 1998). In Hester, the court applied the first three steps set forth in Clement and, after determining that the reissue claims involved were “unmistakably broader” than the patent claims with respect to previously surrendered subject matter,

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went on to further consider “whether the reissue claims were materially narrowed in other respects,” citing Mentor in support of this analysis. Id. at 1483. This additional step appears to directly contradict the minor premise set forth by the court in Clement, namely, that if a “reissue claim is as broad as or broader in an aspect germane to a prior art rejection ... the recapture rule bars the claim.” Clement, 131 F.3d at 1470. Instead of halting their analysis once it was determined that the reissue claims in question were broader than the patent claims with respect to the surrendered subject matter, the analysis used by the Hester court suggested that reissue claims that are broader in an aspect germane to the surrendered subject matter may still avoid the recapture rule if they have been materially narrowed in other respects.

In 2001, the Federal Circuit explicitly adopted this proposition by combining the steps of both Clement and Hester. Pannu v. Storz Instruments, Inc., 258 F.3d 1366 (Fed. Cir. 2001). After reciting the first two original steps set forth in Clement, the court in Pannu added, “[f]inally, the court must determine whether the reissued claims were materially narrowed in other respects to avoid the recapture rule.” Id. (citing Hester in support of this analysis). Although the court in Pannu went on to hold that the reissued claims in that instance were barred under the recapture rule because they were “not narrowed in any material respect”, the third step adopted by this court continues to support the position originally set forth by the court in Hester; namely, that claims broadened in an aspect related to surrendered subject matter may in fact avoid the recapture rule if they are materially narrowed in other respects. Unfortunately, the Federal Circuit has yet to decide a case directly dealing with this issue.

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### III. Recent Board Decisions

Although the Federal Circuit has yet to decide a case directly dealing with the holding in Pannu, the Board of Patent Appeals and Interferences has, as recently as six months ago or so, expressly held that reissued claims which omit limitations relied upon to overcome a prior art rejection are not barred by the recapture rule *per se*. Ex Parte Eggert, 67 U.S.P.Q.2d 1716, 1729 (Bd.Pat.App. & Interf. 2003). In harmonizing their decision with the analysis set forth by the Clement court, the Board in Eggert recognized that the third step of the Pannu test “clearly also leaves open the possibility that reissue claims which have been broadened in an aspect related to surrendered subject matter may avoid the recapture rule if they are materially narrowed in other respects.” Id. at 1727.

An analysis of the facts in Eggert may prove beneficial in understanding the Board's holding. In Eggert, the contested reissue claims omitted limitations which were added by the applicant during prosecution of the original claims in order to overcome a prior art rejection. Id. at 1731. Applying the first step of the three-step process of Pannu, the Board found that “the reissue claims have been broadened relative to patent claim 1.” Id. Next, in applying the second step of the Pannu process, the Board determined that because the applicants amended original claim 1 in an effort to overcome the prior art rejection, the applicants had effectively “conceded that claim 1 prior to that amendment was not patentable, thereby surrendering the subject matter of that claim.” Id. Accordingly, the Board stated that “the omission of [this] limitation in [the] reissue claims ... is in an aspect germane to the prior art rejection.” Id. Finally, in applying the third step of Pannu, the Board found that even though the limitations added to the original claims to overcome the prior art rejection were not present in the reissue claims, the reissue claims were in fact narrower than the original claim prior to this amendment in a manner which related directly to the prior art rejection. Id.

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The decision in Eggert appears to base its decision on three main premises. First, if limitations are added to patent claims in order to overcome a prior art rejection, the applicant has effectively conceded that those claims prior to amendment were unpatentable, and the original claim therefore represents surrendered subject matter. Second, in order to be allowable, reissue claims must amend the scope of the original claims in a manner which effectively narrows their scope relative to the original prior art rejection. Third, while these reissue claims cannot be as broad or broader than the *surrendered subject matter* (or the original claims as drafted prior to the amendment) in an aspect germane to the rejection, they may actually be broader than the *issued patent claims* in an aspect germane to a prior art rejection.

This recent decision effectively manifests the Board's reluctance to hold reissue claims barred by recapture *per se* if they do not include limitations added to the patent claims in order to overcome prior art rejections. As stated by the Board in Eggert, the proper inquiry instead involves a "fact-specific analysis in each case to determine whether the patentee is attempting to recapture by reissue subject matter than was surrendered during the prosecution of the patent application." Id. at 1727.

#### **IV. Conclusion based on Recent Precedents**

Based on the foregoing, recent decisions by both the Federal Circuit and Board of Patent Appeals and Interferences support the position that reissue claims which have omitted limitations which were added to the original patent claims in order to overcome a prior art rejection are not impermissible *per se*, but must be judged on a fact-specific analysis and on a case-by-case basis.

The recent holding of Eggert is especially useful in analyzing the application of the recapture rule to the present case. Although the reissue claims in the reissue application omit limitations which were added to the patent claims of patented case in order to overcome a prior art rejection, according to the holding of Eggert this does not constitute a *per se* application of the recapture rule, as is argued by the Examiner. Instead, the Examiner must determine whether the reissue claims of this reissue

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application are as broad or broader than the surrendered subject matter of the patented file (or the original claims as drafted prior to amendment), and *not* merely whether they have omitted limitations which were added to the original patent claims in order to overcome the prior art rejections.

Thus, the Applicant contends that the test applied by the examiner is flawed in view of the case law. The mere fact that certain limitations that made claims 1 and 4 patentable in the issued patent is not dispositive, is not the test, and is not a litmus test for the conclusions asserted in this Action.

The manner in which the pending claims are materially narrowed has been explored on this record, and is reasserted here as if fully repeated herein. See, for example: (1) the original Preliminary Amendment and statement of support for all claims in the original reissue application, and especially the chart at pages 14 to 21 showing the broadening and narrowing aspects of the originally-filed claims; (2) pages 2 and 3 of the January 3, 2002 response; (3) pages 4 to 8 of the Response dated June 14, 2002; (4) pages 2 to 5 of the Response dated November 20, 2002. See also MPEP1412.02 (8<sup>th</sup> Ed.) incorporated Assistant Commissioner Kunin's memorandum on the point.

The issues presented here are not such that the recapture rule comes into play, given the narrowing of the claims, relative to their broadening. In this respect at least, the first lengthy sentence on page 3 of the Action does not meet the required test. Merely referring to an indication that the pending reissue claims are "broader" than the patent claims is not sufficient to meet the prevailing and required analysis.

A new non-final Action is requested making the requisite analysis to prepare this application for appeal if necessary.

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